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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/194,796	12/01/1998	PETER JOHN HULME	S1022/8152	3615

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EXAMINER

ZIMMERMAN, BRIAN A

ART UNIT

PAPER NUMBER

2635

DATE MAILED: 02/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/194,796

Applicant(s)

HULME, PETER JOHN

Examiner

Brian A Zimmerman

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 23-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 23-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Status of Application

In response to the applicant's amendment received on 12/16/02. The examiner has considered the new presentation of claims and applicant arguments in view of the disclosure and the present state of the prior art. And it is the examiner's position that claims 1,23-41 remain unpatentable for the reasons set forth in this office action:

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1,23-25,28,32,33,41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsurumoto (US 4817203) and Kwoh (5852478).

Tsurumoto shows a first apparatus 4, which receives signals from a first remote transmitter 8. The first apparatus also includes a memory 23, which stores control signals for a plurality of second apparatuses 5,6,7. In response to certain signals from the remote transmitter, the first apparatus transmits a converted control signal to one the second apparatuses.

In an analogous art Kwoh teaches the use of the broadcast medium to send signals to a first device that are then transmitted to the second device for control of the second device (second control signals). This assists the user in programming a VCR to record a program, and it would have been obvious to one of ordinary skill in the art at

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the time of the invention to have used such a feature in the Tsurumoto system to provide such a benefit.

Tsurumoto differs from the claimed invention since the first and second apparatuses claimed communicate via a wireless connection as opposed to a wired connection of Tsurumoto. However, it is well known in the art of communication that the use of wireless communication provides certain well-known advantages, for example; no need to run cables, and the ease of setting up communication "networks". Due to such a well known nature of converting wired communication to wireless communications, such would have been obvious to one of ordinary skill in the art at the time of the invention.

With regard to the to limitation that there be a second remote controller "distinct" from the first remote controller. It is interpreted by the examiner that when the slide switch of the remote controller of Tsurumoto is in position A such a remote controller is not the same as the remote controller when the switch is in position B, and is therefore distinct. Furthermore, it is well known (not only in the art) to have OMR or (Original Manufacture Remote) that is packaged with a VCR, for example, such that each device would necessarily include it's own separate and distinct remote controller.

2. Claims 26,27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsurumoto and Kwoh as applied to claim 1 above, and further in view of Miyagawa (4989081).

In an analogous art, Miyagawa shows a system where a first apparatus is used to control a plurality of second apparatuses, and the plurality of second apparatuses include a sound system 16 and a home automation system 23. This permits the user to control as many systems/subsystems with one controller thus increasing the efficiency of the single remote control. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used the home bus technique taught by Miyagawa in the Tsurumoto system in order to increase the usefulness of the remote control system.

3. Claims 29,30,31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsurumoto and Kwoh as applied to claim 1 above, and further in view of Mills (6088355).

In an analogous art, Mills shows a cable decoder, which is generally associated with the image receiving circuit. This cable decoder of Mills is programmable. Mills can program the device using a smart card or signals received from the broadcast signal. See col. 11 lines 13-54 and col. 9 lines 9-40. The examiner is aware that there are many methods of programming command data into devices. Here Mills shows two that are used in the art of Television systems. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used the programming technique taught by Mills in the Tsurumoto system in order to provide easy programming of the system.

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4. Claims 34-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsurumoto and Kwoh as applied to claims 1 and 32 above, and further in view of Geiger (508534).

In an analogous art, Geiger shows a remote control system with first and second apparatuses, where the first apparatus sends control signals to the second apparatus in response to signals received from a remote controller. Geiger also shows a further remote controller, which can be used to control the first apparatus. This shows that each apparatus can have a dedicated remote controller in addition to the system's "universal" remote controller. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used the multi-"remote controller" technique taught by Geiger in the Tsurumoto system in order to allow increased control of the remote control system.

Response to Arguments

Applicant's arguments filed 12/16/02 have been fully considered but they are not persuasive.

The applicant argues that there is no motivation to combine Tsurumoto and Kwoh. The examiner pointed to motivation in the rejection repeated above, namely such a feature would assist the user in programming a VCR to record a program.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves **or in the knowledge generally available to one of ordinary skill in the art**. Motivation does not need to be found in the references alone. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as the applicant agrees on page 3 (middle of the second full paragraph), such a combination would make it easier for a user to program the VCR.

The applicant argues that the Tsurumoto explicitly teaches away from combining with Kwoh because Kwoh teaches multiple remote controls. This is not correct. The only way a reference can be considered to teach away is if expressly teaches that something would not work. If a reference teaches that an alternative embodiment does not perform as well at some task, this cannot be considered teaching away.

The applicant makes arguments beginning in the last paragraph of page 4 and continuing through the first full paragraph of page 5 (of the 12/16/02 response) directed to elements the applicant believes the references do not show, however the applicant argues that Tsurumoto does not show elements that the examiner pointed to Kwoh for teaching. Likewise the applicant argues that Kwoh does not show features, which

Tsurumoto was cited for teaching. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The applicant argues that there is no motivation for the assertion that wireless communication is advantageous. This argument is confusing since the applicant then agrees with the examiner that a) wireless communication systems are well known, and b) provide advantages of "no need to run cables". It appears that the applicant is again looking for this motivation to be expressly stated in the references, however as pointed out above, such is not necessary.

The applicant argues that the references do not teach two physically distinct devices (page 6 or arguments). It is noted that the claims **do not** require that the two devices be **physically** distinct. Since the references (namely Tsurumoto) shows distinct operation, it teaches the claimed distinct remote controls as fairly interpreted from the claims.

The applicant argues that the Office Action asserts inherency of each device having it's own remote controller. This is not what the Office Action asserts at all. The Office Action (repeated above) states that it is well known (or obvious) to have OMR or

(Original Manufacture Remote) that is packaged with a VCR. The applicant expressly does not dispute this obviousness, page 7 of the response (12/2/02).


THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian A Zimmerman whose telephone number is 703-305-4796. The examiner can normally be reached on Off every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Horabik can be reached on 703-305-4704. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.



Brian A Zimmerman
Primary Examiner
Art Unit 2635

BaZ
February 14, 2003